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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,425	01/26/2001	Xaveer Van Ostade	4644US	8053

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EXAMINER

LI, RUIXIANG

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/771,425

Applicant(s)

OSTADE ET AL.

Examiner

Ruixiang Li

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-11, 14-16, 18 and 21-25.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The amended claims 24 and 35 recite "comparing the inhibiting activity of said series of compound to a control reaction". It is unclear what are the metes and bounds of the claims because the term "a control reaction" is not defined unambiguously in the specification. Thus, the amendment raises an issue of indefiniteness under 35 U.S.C. 112, 2nd paragraph.

Continuation of 5. does NOT place the application in condition for allowance because: (i) the rejection of claims 11, 15, 16, 18, 24, and 25 under 35 USC 112, second paragraph, remains; (ii) the rejection of claims 1-11, 14-16, 18, and 21-25 under 35 U.S.C. 103 (a) also remains.

(i) Rejection of claims 11, 15, 16, 18, 24, and 25 under 35 USC 112, second paragraph, remains because claims 11, 24, and 25, even after being amended, still do not require measuring the binding of a ligand to a chimeric receptor; the step of contacting the eukaryotic cells with a ligand of the chimeric receptor is still missing. Claims 15, 16, and 18 have not been amended in response to final rejection.

Applicants argue that the activation or deactivation of the reporter system is all that is required to perform the screening. This is not persuasive because activation or deactivation of the reporter system is not a indicator of whether a compound (an antagonist) binds to a chimeric receptor.

(ii) Rejection of claims 1-11, 14-16, 18, and 21-25 under 35 U.S.C. 103 (a) remains. Applicants continue to argue that a prima facie case of obviousness cannot be established with regard to any of independent claims 1, 15, 24, or 25 since no suggestion or motivation exists to combine the cited references. This is not persuasive for the reasons set forth in the record (Paper No. 20 & 22).

It is further noted that Applicants acknowledge in the specification (top of page 8) that an antagonist screening system can be realized by using the autocrine loop and adding possible inhibitors to the medium, but it is clear to people skilled in the art that, alternatively, the cell can be transformed with genes encoding candidate inhibitors", supporting the obviousness rejection set forth in the record.

(iii) Information Disclosure Statement

The Information Disclosure Statement submitted on December 4, 2003 has not been considered by the Examiner because certification, petition, and a petition fee are required in order for the Information Disclosure Statement, which is submitted after final Action, to be considered.


GARY KUNZ
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